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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,925	01/09/2001	Christian Quellet	12846/121488	6779

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 04/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/756,925

Applicant(s)

QUELLET ET AL.

Examin r

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Amendment filed on November 29, 2001. Claims 1-27 are pending. Claim rejections under 35 U.S.C. § 112 and claim objections are withdrawn in view of the claim amendments by applicants. Claim rejections under 35 U.S.C. § 103 are maintained for reasons of record as indicated in the previous office action dated August 29, 2001.

Applicants' remarks regarding a missing reference are noted, however, the Office will not issue a second non-final office action solely based on that reason. Such a defect should be brought to the attention of the Office within 1 month of the mail date of the action. See MPEP 710.06. Where the error is called to the attention of the Office within the reply time set in the office action but more than 1 month after the mail date of the office action, the Office will set a new period for reply to substantially equal the time remaining in the reply period, if requested to do so by the applicant. In this case, since the Office was not notified of the defect until the receipt of the Amendment/Response filed on November 29, 2001 (certificate of mail date, however was not received by the Office until January 17, 2002), the last day of the 3 month period set for reply to the previous office action, there is no time remaining in the reply time set in the previous office action. Therefore, the period for reply to that action will not be restarted and a new non-final office action to correct the asserted deficiency will not be issued. Examiner further notes that applicants discuss the Bilbrey patent in question in the reply filed on November 29, 2001, and therefore assumes that applicants nevertheless had the reference at issue and were able to timely reply to the previous office action.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Lengerich (US 6190591 B1) Saleeb et al. (Dev. Food. Scie., 1992) ("Saleeb") and Bilbrey (US 5290547).

The rejection is maintained for reasons of record as indicated in the previous office action dated August 29, 2001.

Response to Arguments

Applicants' arguments filed on November 29, 2001 in response to office action dated August 29, 2001, have been fully considered but they are not persuasive.

1. Applicants argue that the motivation statement in the previous office action is not found in the statute or precedential authority. Examiner respectfully disagrees. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Examine takes the position that the rejection complies with the legal standard above, since it provides the evidence supported by the prior arts, that one having ordinary skill in the art would have found the instant invention obvious. The present

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rejection poses an issue whether, given the general teaching of van Lengerich on encapsulating liquid active components in the form of emulsions, one having ordinary skill in the art would have been motivated to look for specific teaching to make the said composition. Examiner's rejection is based on the obviousness that the skilled worker reading van Lengerich would have looked for more specific teaching in the prior arts to find out what can be used as the liquid active components, which are provided by Saleeb and Bilbrey.

2. Applicants also argue that the rejection does not provide any reason why one would be motivated to combine the references in the manner suggested by the examiner. Applicants also assert that examiner had failed to provide evidence in any of the cited documents of the motivation to combine in the manner suggested. Examiner respectfully disagrees, as the rejection does indicate the motivation would have stemmed from the disclosed beneficial effects of fine emulsion droplets, such as reduced oxidation and extended shelf life, which is found in Saleeb. See p. 660, line 3- p. 661, line 8. Examiner also noted in the previous office action that the emulsifiers and surfactants used in the instant invention are conventionally used in the art, as evidenced in Bilbrey.

3. Applicants assert that van Lengerich nor Saleeb disclose or suggest the use of a water-in-oil microemulsion, and that Bilbrey does not disclose or suggest the encapsulation or suspension of the disclosed microemulsions. Examiner notes that the feature upon which applicant relies (i.e., water-in-oil microemulsions) is not recited in the rejected claim(s). Also, applicants' statement that Bilbrey does not disclose or

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suggest the encapsulation of the disclosed microemulsion is incorrect. As discussed in the previous rejection, Bilbrey discloses coating (which is viewed as equivalent to encapsulation) oil-in-water emulsion droplets, which meets the limitation of the instant claims.

4. Applicants argue that Bilbrey does not teach or suggest smaller droplet size in the range of 0.01 microns to 2 microns, "even though there is a single overlap in ranges" at applicants' high end and Bilbrey's low end. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, again, the general teaching of making encapsulated emulsion via extrusion process is known in the art. See van Lengerich and Saleeb. Saleeb specifically teaches encapsulating liquid actives in the form of fine emulsion droplets having 1-50 microns in size. Furthermore, the fact that droplet size of 2 microns are disclosed in the reference indicates the evidence that the applicants' range would have been an obvious variation of the prior art, optimized by routine experimentations. See MPEP § 2144.05.

5. Applicants also argue that "nothing in Saleeb discloses or suggests an oil-in-water emulsion, and the rejection is absolutely devoid of any disclosure to the contrary". Examiner's presumption of oil-in-water emulsion is based on the disclosure of "dispersion of oil droplets" formed during the extrusion process, which is viewed as an obvious indication that the emulsion in the reference is in the form of oil-in-water

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emulsion. See p. 652, last paragraph, Furthermore, based on the teaching that the emulsifiers are chosen depending on their optimal HLB for particular oils, as indicated in the previous office action, it is implied that the type of emulsion depends on the HLB of the particular emulsifier. Even if Saleeb failed to teach oil-in-water emulsion, which in examiner's view is not the case, nonobviousness of the claimed invention should be shown in view of the *combined references* as whole. In this case, the encapsulation of oil-in-water microemulsion is taught in Bilbrey. The mere fact that Saleeb lacks the explicit mention of the type of its microemulsion does not necessarily render the claimed invention nonobvious.

Nothing nonobvious is seen in the combination of the conventional ingredients produced by the method well known in the art. See MPEP § 716.02. Absent unexpected results supported by evidence, the claimed invention is viewed an obvious variation of the prior arts.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
April 5, 2002


MINNA MOEZIE, J.D.
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